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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/406,269	09/24/1999	JIN-AN JIAO	48551	1426

7590 01/20/2004

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EXAMINER

VOLLANO, JEAN F

ART UNIT	PAPER NUMBER
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1621

DATE MAILED: 01/20/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	09/406,269	JIAO ET AL.	
	Examiner	Art Unit	
	Jean F. Vollano	1621	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 80-84 is/are pending in the application.
- 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 81 and 82 is/are allowed.
- 6) ☒ Claim(s) 80,83 and 84 is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on ____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. §§ 119 and 120

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. ____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
* See the attached detailed Office action for a list of the certified copies not received.
- 13) ☒ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application) since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.
a) ☐ The translation of the foreign language provisional application has been received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121 since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) Paper No(s). ____. |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449) Paper No(s) ____. | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

1. The request for an RCE and the amendment filed 12/4/2003 has been entered. Claims 1-79 have been cancelled and newly added claims 80-84 are pending.

2. The examiner notes that in drafting the new claims applicant has re added a limitation the is “susceptible to undesired thrombosis” which had previously been rejected under 35 USC 112, 2 the term has been eliminated from claim 82 but not from claim 84. The examiner will rewrite the rejection as it applies to claim 84.

Claim Rejections - 35 USC § 112

Claim 84 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim 84 recites the limitation of “susceptible to undesired thrombosis”. The claims is confusing as to what is “desired” thrombosis versus “undesired” thrombosis? Is there a thrombosis that is desired? The claim is confusing as to the metes and bounds that are being claimed.

Claims 84 is also unclear as to what is meant by “susceptible to”. Does this mean that there are only certain people that may develop thrombosis? Or does this mean that the population being claimed is one whou have had previous thrombotic episodes which have been treated and are

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dormant? The claim is confusing as to the metes and bounds that are being claimed as the instant invention? The examiner noted if claim language was changed to be consistent with the broader claim 82 then the claim would also be allowable.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(a) the invention was known or used by others in this country, or patented or described in a printed publication in this or a foreign country, before the invention thereof by the applicant for a patent.

3. Claims 80 and 83 are rejected under 35 USC 102(a) as being anticipated by Chem abs 653 (CA:123:33653).

Chem abs 653 teaches a compound of formula 1 of claim 80 wherein one X is H and the other is an optionally substituted alkyl amino group wherein the amine is optionally substituted with an imino(nitroamino) methyl etc chain and n is 1 wherein X' and Y' are hydrogen, Het=O, m=1 and wherein X and Y are H and Ar is a substituted phenyl.

When Chem 653 teaches that the compound is used to inhibit the endothelin converting enzyme in blood coagulation disorders then the claims are fully anticipated.


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4. Claim 81 is allowable. The prior art does not anticipate or suggest the method being claimed wherein Ar in formula I represents a heteroaryl group which may be optionally substituted.
5. Claim 82 is also allowable. The prior art does not suggest or anticipate the method of claim 82 wherein a compound of formula I is used for the treatment of thrombosis.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jean F. Vollano whose telephone number is 703-305-4483. The examiner can normally be reached on Monday-Thursday 6:30 - 5:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Johann Richter can be reached on 703-308-4532. The fax phone number for the organization where this application or proceeding is assigned is 703-308-4556.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-1235.


Jean F. Vollano
Primary Examiner
Art Unit 1621

January 13, 2004